



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/081,776

02/20/2002

James M. Barton

TIVO0003C-D

4827

29989

7590

11/03/2006

HICKMAN PALERMO TRUONG & BECKER, LLP
2055 GATEWAY PLACE
SUITE 550
SAN JOSE, CA 95110

EXAMINER

NGUYEN, HUY THANH

ART UNIT

PAPER NUMBER

2621

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/081,776	Applicant(s) BARTON ET AL.	
	Examiner HUY T. NGUYEN	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-28 and 48-110 is/are pending in the application.
- 4a) Of the above claim(s) 59-110 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-28 and 48-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/23/06, 5/19/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09 August 2006 has been entered.

Election/Restrictions

2. Newly submitted claims 59-108 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The newly added claims 59-69 and 74-106 are directed to apparatus for processing and accessing the frame using identification signal and claims 70-73 and 107-110 are direct to apparatus for controlling recording and storing the programs in a storage device and buffers that is distinct from claim 20-28 and 48-58. The newly added claims 59-108 do not require any means for using recorded program list for simultaneously playing the recorded program with the program whose storage is in progress as required by claims 20-38 and 48-58, and claims 20-28 and 48-58 do not require any means for using identification signal for accessing frames as required by

Art Unit: 2621

claims 59-69 and 74-106 , or controlling recording programs in a storage device and buffers as required by claims 70-73 and 107-110.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 59-108 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 2621

4. Claims 20 –28 and 48-58 rejected under 35 U.S.C. 103(a) as being unpatentable over Browne et al (WO 92/22983) in view of Akiba et al (6,542,695) and Logan et al (5,371,551).

Regarding claims 20 and 48, Browne discloses a process and an apparatus for a digital video recorder, comprising the steps of storing a plurality of multimedia programs in digital form on a storage device (page 3) ; displaying a list of previously recorded multimedia programs stored on said storage device to a user(Fig. 6, page 24) , wherein the user selects previously recorded multimedia programs from said list; simultaneously playing back at least one of said selected previously recorded multimedia programs and a multimedia program whose storage is in progress t(page 3, lines 18-24) .

Browne fails to specifically teach displaying the multimedia program whose storage is in progress. Akiba discloses a recording/ reproducing apparatus having a control means for displaying a program whose storage is in progress (Figs. 7,8,13-15, column 2, lines 20-37) . It would have been obvious to one of ordinary skill in the art modify Browne with Akiba by providing a control means a taught by Akiba with the apparatus of Browne for displaying the program whose storage is in progress thereby enhancing the capacity of the apparatus of Browne in selecting the programs to be stored or reproduced .

Browne as modified with Akiba fails to teaches that the playing back step allows playback rate and direction of each multimedia program to be controlled individually and

simultaneously to perform any of: at least a fast forward, and rewind frame step, pause, and play functions. However it is noted that providing a control mean for each multimedia program to be controlled individually and simultaneously to perform one of: fast forward, and rewind frame step, pause, and play functions is well known in the art as taught by Logan (column 5, lines 30 to column 6, line 15). It would have been obvious to one of ordinary skill in the art to modify Browne with Logan by providing apparatus of Browne with a control means as taught by Logan thereby providing more convenience to the users in searching a portion of a program for viewing.

Regarding claims 21 and 49, Browne as modified with Akiba further teaches the playing back step converts said at least one of said selected multimedia programs and said multimedia program whose storage is in progress into display output signals (See Browne , column 6, Akiba (Figs. 7-8) ;

Regarding claims 22 and 50, Browne teaches the process of Claim 21, further comprising the step of inserting on-screen displays into a display output signal (page 28, Fig. 10).

Regarding claims 23 and 51, Browne as modified with Logan teaches the process of Claim 20, wherein a user controls the playback rate and direction of a multimedia program through a remote control (See Logan (column 5).

Regarding claims 24 and 52, Browne further the step of providing a multimedia recording device, wherein said playing back step sends a multimedia program to said multimedia recording device, allowing a user to record said multimedia program (page 20)

Regarding claims 25 and 53 , Browne further teaches the step of:
providing editing means for creating custom sequences of video and/or audio output;
and
wherein said editing means allows any number of video and/or audio segments of
multimedia programs to be lined up and combined and stored on said storage device
(pages 28-30).

Regarding claims 26 and 54, Browne further teaches the process of Claim 20,
further comprising the steps of. providing a plurality of input signal tuners;
wherein said tuners accept analog and/or digital multimedia program signals; wherein
each of said tuners is individually tuned to a specific multimedia program; and
converting analog multimedia programs into a digital representation (Fig. 1).

Regarding claims 27 and 55, Browne further teaches the step of
providing means for synchronizing video and audio components for proper playback
(Fig. 3).

Regarding claim 28 and 56, Browne teaches an input signal tuner receiving
data.

Regarding claim 57, Browne further teaches , wherein said playing back step
plays back said at least two of said multimedia programs in a picture in a picture format
to a display device (page 21).

Regarding claim 58, Browne further teaches the playing back module plays back
said at least two of said multimedia programs in a picture in a picture format to a display
device (page21).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lynch et al and Takagi et al teach apparatus for simultaneously playing the recorded programs and recording programs.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T. NGUYEN whose telephone number is (571) 272-7378. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

H.N

HUY T. NGUYEN
PRIMARY EXAMINER